

Remarks

In the present response, 7 claims (1, 5, 8, 9, 11, 15, 17) are amended. Claims 1-3, 5-15, and 17-20 are presented for examination. No new matter is added.

II. Claim Rejections: 35 USC § 102

Claims 1, 2, 3, 5, 6, 8, 9, 15, and 17-20 are rejected under 35 USC § 102(e) as being anticipated by USPN 6,330,976 (hereinafter Dymetman). This rejection is traversed.

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. See MPEP § 2131, also, *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983). Since Dymetman neither teaches nor suggests each element in claims 1, 2, 3, 5, 6, 8, 9, 15, and 17-20, these claims are allowable over Dymetman. Applicant presents arguments with respect to the independent claims.

Claim 1

Claim 1 recites numerous limitations that are not taught or suggested in Dymetman. For example, claim 1 recites an **electronic tablet** having visible marking capability. Nowhere Dymetman does teach or suggest an electronic tablet as claimed. By contrast, Dymetman expressly provides examples of a marking medium as "sheets of paper and plastic" (7: 45-46).

The Office Action cites column 26, lines 19-30 for teaching an electronic tablet. This section of Dymetman states: "Ariane has previously connected to the Web pages provided with the coded substrate **document** that she's reading (Othello)" (emphasis added: 26: 21-23). Dymetman, however, expressly defines the term "document" as follows:

A "physical page" or "page" is a marking medium that includes **only one sheet; a card, a poster, and an ordinary sheet** are all pages within this meaning. A "hardcopy document" or **"document" is a collection of one or more pages**, with at least

one page including markings indicating information. A "sticker" is a page that can be made to adhere to a surface. (Emphasis added: col. 7, line 66 – col. 8m line 5).

Thus, Dymetman expressly teaches that the marking medium is sheet, card, a poster, or ordinary sheet. Nowhere does Dymetman teach or suggest that the marking medium is an electronic tablet.

For at least these reasons, claim 1 is allowable over the art of record. The dependent claims are allowable for at least these reasons.

Claim 5

Claim 5 recites numerous limitations that are not taught or suggested in Dymetman. For example, claim 5 recites several recitations concerning a **computer writing tablet**. Nowhere Dymetman does teach or suggest a computer writing tablet as claimed. By contrast, Dymetman expressly teaches that the marking medium is a sheet, a card, a poster, or an ordinary sheet (see citations in connection with claim 1). Nowhere does Dymetman teach or suggest that the marking medium is a computer writing tablet.

The Office Action additionally cites col. 3, lines 62-67 of Dymetman. This section expressly teaches that "the marking medium is **page**" (emphasis added: 3: 57-58). As noted above, a "page" in Dymetman is a sheet, a card, a poster, or an ordinary sheet (see col. 7, line 66 – col. 8, 5). Nowhere does Dymetman teach or suggest that a "page" is a computer writing tablet.

For at least these reasons, claim 5 is allowable over the art of record. The dependent claims are allowable for at least these reasons.

Claim 8

Claim 8 recites numerous limitations that are not taught or suggested in Dymetman. For example, claim 8 recites several recitations concerning a **computer writing tablet**. Claim 8 is allowable for at least the reasons given in connection with claim 5.

The Office Action additionally, cites col. 30, line 64 – col. 31, line 40 in Dymetman. This section of Dymetman teaches that a pointer can draw, write, or mark on a coded substrate. Dymetman, however, never teaches or suggests that the coded substrate is a computer writing tablet. Positions of the pointer do translate to strokes on a digital page, but the marking medium is not a computer writing tablet.

For at least these reasons, claim 8 is allowable over the art of record. The dependent claims are allowable for at least these reasons.

Claim 15

Claim 15 recites numerous limitations that are not taught or suggested in Dymetman. For example, claim 15 recites several recitations concerning a **computer writing tablet**. Claim 15 is allowable for at least the reasons given in connection with claim 5.

Claim 17

Claim 17 recites numerous limitations that are not taught or suggested in Dymetman. For example, claim 17 recites several recitations concerning a writing **digitizer tablet**. Claim 17 is allowable for at least the reasons given in connection with claim 5. The dependent claims are allowable for at least these reasons.

II. Claim Rejections: 35 USC § 103

Claims 7 and 10-14 are rejected under 35 USC § 103 as being unpatentable over Dymetman in view of USPN 6,766,494 (Price). This rejection is traversed.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Applicant asserts that the rejection does not satisfy these criteria.

Independent claim 11 recites numerous recitations that are not taught or suggested in the art of record. For example, claim 11 recites a **computer writing tablet** as the marking medium.

The Office Action cites column 26, lines 19-30 for teaching an electronic tablet. This section of Dymetman states: "Ariane has previously connected to the Web pages provided with the coded substrate **document** that she's reading (Othello)" (emphasis added: 26: 21-23). Dymetman, however, expressly defines the term "document" as follows:

A "physical page" or "page" is a marking medium that includes **only one sheet; a card, a poster, and an ordinary sheet** are all pages within this meaning. A "hardcopy document" or "**document**" is a collection of one or more pages, with at least one page including markings indicating information. A "sticker" is a page that can be made to adhere to a surface. (Emphasis added: col. 7, line 66 – col. 8m line 5).

Thus, Dymetman expressly teaches that the marking medium is a sheet, a card, a poster, or an ordinary sheet. Nowhere does Dymetman teach or suggest that the marking medium is a computer writing tablet.

The Office Action additionally cites col. 3, lines 62-67 of Dymetman. This section expressly teaches that "the marking medium is **page**" (emphasis added: 3: 57-58). As noted above, a "page" in Dymetman is a sheet, a card, a poster, or an ordinary sheet (see col. 7, line 66 – col. 8, 5). Nowhere does Dymetman teach or suggest that a "page" is a computer writing tablet.

For at least these reasons, claim 11 is allowable over Dymetman. Perry fails to cure the deficiencies of Dymetman. The dependent claims are allowable for at least these reasons.



CONCLUSION

In view of the above, Applicant believes all pending claims are in condition for allowance. Allowance of these claims is respectfully requested.

Any inquiry regarding this Amendment and Response should be directed to Philip S. Lyren at Telephone No. (281) 514-8236, Facsimile No. (281) 514-8332. In addition, all correspondence should continue to be directed to the following address:

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CERTIFICATE UNDER 37 C.F.R. 1.10

The undersigned hereby certifies that this paper or papers, as described herein, is being deposited with the United States Postal Service 'Express Mail Post Office to Addressee' service under 37 CFR 1.10 in an envelope addressed to: Commissioner for Patents, Alexandria VA 22313-1450 on this the 23rd day of November, 2005.
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